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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,256	03/10/2004	Robert P. Fagan	ZM756/04001	5360
22884	7590	06/13/2006		
MIDDLETON & REUTLINGER 2500 BROWN & WILLIAMSON TOWER LOUISVILLE, KY 40202			EXAMINER PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 06/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/797,256	Applicant(s) FAGAN, ROBERT P.	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 11-14 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 7 and 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/07/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is responsive to communication received 03/31/2006 – Election and Amendment; Power of Attorney.

Claims 1-7, 11-14 and 20 remain pending.

#### ***Response to Amendment***

In the amendment, received 03/31/2006, the applicant, at the outset, appears to be traversing the restriction/election requirement set forth in the action, mailed 03/03/2006. With the cancellation of claims 15-19, the applicant has apparently moved to the election of the Group I set of claims. In further consideration of the Group I set of claims, the applicant has apparently elected to continue prosecution with an examination of the claims directed to Species II. However, it is not clear exactly which part of the election requirement the applicant is traversing, other than to note that the applicant believes that original claim 1 and new claim 20 both read on the elected Species II. The applicant addresses what he calls a “non-distinct feature” recited in at least claim 1, which is alleged to be a part of all of the Species and further indicates that there would not appear to be any burden to conduct a single search related to the generic independent claims.

Though it may be agreed that claims 1 and 20 are “generic” to a plurality of patentably distinct species, the “burden” that the applicant is referring to would not appear to be directed to the examination of all of the distinct species set forth in the requirement. It would not appear that the applicant is traversing the position of the Office that Species I through VII are distinct. For example, the applicant has not

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submitted evidence or identified such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case.

Rather, the applicant appears to simply be reiterating that claim 1 is generic and that at least claims 1 and 20 are related to the elected Species II. Since the applicant has identified and explained what the applicant feels is an error in the original restriction requirement, i.e., an error in the restriction statement that no claims are generic, the election shall be treated as an election with traverse. However, in response to this traversal, it is again noted that no argument has been made with respect to the burden associated with examining all of the identified species. Thus, only claims directed to elected Species II will be treated on the merits herein below.

Claims 3, 4, 7 and 11-14 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 03/31/2006.

Following is an action on the merits for claims 1, 2, 5, 6 and 20, each being readable on elected Species II:

### ***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Burrows ('129). Note flat face (23) along with curvilinear striking surfaces formed by balls (22). The claimed "striking line" has no defined boundaries and is not defined relative to any defined plane, line or club head orientation. In other words, when considered in its broadest sense, the Burrows device includes a first striking line and a second striking line, considering that a golf ball may be struck by any portion of the flat face or any portion of the curvilinear face, depending upon how the club head is arranged and held at address. Moreover, the claimed "greater than a radius of a golf ball" offers no reasonable explanation of exactly what the size of the claimed golf ball is. As such, the Burrows patent anticipates a claimed structure in which the golf ball is at least smaller than the diameter of the radius of the two balls (22).

Claims 1, 5 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Long ('215). Note the flat face shown in Figure 3 along with curvilinear striking surfaces formed by the end surfaces of the head, as shown in Figures 1 and 4. The claimed "striking line" has no defined boundaries and is not defined relative to any defined plane, line or club head orientation. In other words, when considered in its broadest sense, the Long device includes a first striking line and a second striking line, considering that a golf ball may be struck by any portion of the flat face or any portion of

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the curvilinear face, depending upon how the club head is arranged and held at address. Moreover, the claimed "greater than a radius of a golf ball" offers no reasonable recitation of exactly what the size of the claimed golf ball is. As such, the Long patent anticipates a claimed structure in which the golf ball is at least smaller than the diameter of the radius of the two end surfaces of the head.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Allport ('937). Figure 7 clearly shows a flat striking surface (49) along with at least one curvilinear striking surface (46). The claimed "striking line" has no defined boundaries and is not defined relative to any defined plane, line or club head orientation. In other words, when considered in its broadest sense, the Allport device includes a first striking line and a second striking line, considering that a golf ball may be struck by any portion of the flat face or any portion of the curvilinear face, depending upon how the club head is arranged and held at address. Specific to claim 2, the radius of the curvilinear surface is described as being greater than 0.84 inch (see col. 2, lines 33-65).

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith ('975). Reference is made to flat striking face (1) and curvilinear striking area (C). The claimed "striking line" has no defined boundaries and is not defined relative to any defined plane, line or club head orientation. In other words, when considered in its broadest sense, the Smith device includes a first striking line and a second striking line, considering that a golf ball may be struck by any portion of the flat face or any portion of the curvilinear face, depending upon how the club head is arranged and held at

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address. Specific to claim 5, the arcuate or concave portion (8) is described as being in the top portion of the head (see col. 2, lines 62-70).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith ('975). Although no particular radius has been provided for the arcuate or concave portion (8) detailed by Smith, it is clear that the arcuate portion should display a radius larger than a golf ball, as evidenced by the relationship shown in Figure 2 between the extended curvature of the concave portion (8) and the diameter of the ball used (B). Since no specifics have been established to relate the claimed radius limitations to either the size of the head or the size of the golf ball used to practice the invention, it is clear that this dimension may be selected as appropriate by the skilled artisan. Here, the skilled artisan would have learned from the Smith device that the concave should be larger than the diameter of a golf ball. For a USGA golf ball, this concave would be larger than the diameter of the ball and thus larger than 0.875 inch in radius.

### ***Claim Objections***

Claims 2 and 6 are objected to because of the following informalities: "inches" should read --inch-- in each occurrence in each claim, as a dimension less than 1.0 inch should not be referred to in the form of inches. Appropriate correction is required.

### ***Further Prior Art of Interest***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baumann and Antonious show putter heads having upper concave surfaces. See Figure 4 in Hanson. Reuter shows a putter head with curved end portions. Johnson and Bernhardt show concave areas on the top of a putter head.

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Note the diameter of the cylindrical head shown in Drake. Strop shows curved ends on a putter.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Passaniti/sp  
June 9, 2006

  
**Sebastiano Passaniti**  
Primary Examiner